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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/976,579	11/24/1997	JAMES D. THORNTON	JAO-34191	2070

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EXAMINER
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BROWN, CHRISTOPHER J

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 01/15/2004

33

Please find below and/or attached an Office communication concerning this application or proceeding.

8x

# Office Action Summary

Application No.

08/976,579

Applicant(s)

THORNTON ET AL.

Examiner

Christopher J Brown

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 29-37, 39-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-37 and 39-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 11/10/03 have been fully considered but they are not persuasive.

Applicant argues that the preamble should be given weight in determining what is required by the claims. As recently as May of this year, in *Storage Technology vs. Level One*

*Communications*, the CAFC has indicated that preambles are not necessarily given weight in determining the meaning of the claims. This has become an issue in the prosecution of this

application; applicant has argued the meaning but has not actually amended the body of the claims to include the limitations for which he is arguing. Before the USPTO, while the claims remain malleable, the appropriate way to change the meaning of the claims is to amend them.

While the court is facing fixed claims it must interpret, applicant has had numerous opportunities to actually put the language in the body of the claims.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching,

suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.

1992). In this case, the knowledge would be generally available to one of ordinary skill in the art.

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The grounds of rejection may be found on the following pages.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless

(h) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country. more than one year prior to the date of application for patent in the United States

**Claims 29-35, are rejected under 35 U.S.C. 102(b) as being anticipated by Fajkowski US 5,905246.**

As per claim 29, Fajkowski discloses a system for decoding and using tokens encoded in a document, by means of a barcode embedded in a coupon, (Cot 5 lines 51-62). The bar codes are decoded by scanning them with a coupon card mechanism, which matches the number of the barcode to coupon data, and displays it on the screen of the coupon card (Col 11 lines 46-56. Fig 4b). The coupon card is a selector that lists decoded tokens, (Col 12 lines 18-25, Fig 4b).

As per claim 30, Fajkowski discloses the coupon card allowing a user to select one or more of the decoded tokens, (Cot 12 lines 26-32).

As per claim 31, Fajkowski discloses the document is a paper document, in this case, a coupon, (Col 4 lines 7-I 1).

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As per claim 32, Fajkowski discloses a coupon card to act as a selector means for selecting a token from a list of decoded tokens, (Col 12 lines 18-25, Fig 4b).

As per claim 33, Fajkowski teaches that the document is a paper document, in this case, a coupon, (Col 4 lines 7-11).

As per claim 34, Fajkowski teaches a method of decoding a user selectable token. encoded into a document, in the instance of a barcode in on a coupon, (Col 3 lines 51-62). Fajkowski discloses creating a list of decoded tokens, (Col 12 lines 18-25, Fig 4b).

As per claim 35, Fajkowski discloses a method of selecting a decoded token from a list of decoded tokens, (Col 12 lines 26-32).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

a. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 36, 37, 39-45 are rejected under 35 U.S.C. 103(x) as being unpatentable over Zdybel US 5,486,686 in view of Laszlo US 5,331,547.**

As per claim 39, Zdybel teaches generating at least one user selectable token in the form of a glyph, (Col 8 lines 30-38, 47-50). Zdybel teaches that the glyphs are printed on paper with a human readable identifier of descriptive text, (Col 8 lines 30-38).

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Zdybel does not teach a token relating to at least one other document, that document being electronic.

Laszlo teaches using a token to link a hardcopy document to a related electronic document, (Col 4 lines 31-34, 66-68, Col 5 lines 1-4).

It would be obvious to one of ordinary skill in the art to modify Zdybel's token system with Laszlo's linkage to related documents, because this expands the range of links Zdybel's system can create and use.

As per claim 40, Zdybel discloses the human readable identifier to be descriptive text, (Col 8 lines 30-38). As per claim 41, Zdybel discloses a printing at least one token with accompanying human identifier, on paper (Col 8 lines 47-50).

As per claim 36, 37, and 42, Zdybel does not disclose a token relating to at least one other document that document being an electronic document.

It would be obvious for one skilled in the art to modify Zdybel with Laszlo, who discloses a token that links the paper document to at least one other electronic document, (Laszlo Col 4 lines 31-34, Col 5 lines 66-68, Col 5 lines 1-4). This modification beneficially expands the range of links for Zdybel's tokens.

As per claim 43, Zdybel teaches that the token relates to information that simulates the environment described in the paper document. Such as the electronic version of the document, (Col 4 lines 64-67, Col 5 lines 1-2).

As per claim 44, Zdybel teaches printing at least one encoded token, a glyph, and human readable identifier on paper, (Col 8 lines 30-38, 47-50).

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As per claim 45, Zdybel discloses scanning at least one user selectable token, (Col 9 lines 46-53).

***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher J Brown whose telephone number is 703-305-8023. The examiner can normally be reached on 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Morse can be reached on 703-308-4789. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7239 for After Final communications. Any inquiry of a general nature or relating to the

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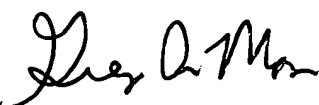
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status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Christopher J. Brown

12/18/03

Handwritten signature of Christopher J. Brown, consisting of the letters 'CJB' in a stylized, cursive script.Handwritten signature of Gregory Morse, appearing to read 'Greg A. Morse' in a cursive script.

GREGORY MORSE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100